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EXAMINER
CHENCINSKI, SIEGFRIED E

ART UNIT	PAPER NUMBER
3692	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	09/991,379	MASCAVAGE ET AL.
	Examiner	Art Unit	
	Siegfried E. Chencinski	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 October 2006</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   **Claim 1** recites the limitation "funds transaction server" in the first element.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   **Claims 1-7, 9-15 & 17-20 are rejected** under 35 U.S.C. 103(a) as being

unpatentable over Wilf et al (US Patent 5,899,980, hereafter Wilf) in view of Stein et al.

(US Patent 5,826,241, assigned to PayPal, hereafter Stein), Fung et al. (US PreGrant

Publication 2002/0055909, hereafter Fung) and Applicant Admitted Prior Art (hereafter

AAPA).

Re. Claim 1, Wilf discloses a method for authorizing and checking out from an online

purchase between a customer and a vendor site/merchant system, the method

comprising steps of:

- at a funds transaction server, receiving transaction information from the vendor

    site, wherein the transaction information comprises a transaction amount (Col. 2,

    ll. 1-15; 26-51. Wilf calls the "transaction amount" the "transaction sum".);

- from the funds transfer server, interacting with the equivalent of a pop-up window

    to present a transaction amount in the equivalent pop-up window and receive

    customer assent to the transaction amount. (The term "transaction detail" is an

    integral component of Wilf's preferred term "transaction data" for approval by the

    customer/user. Wilf uses this term throughout the reference. Examples are Col.

    2, lines 30, 35, 37 and following throughout the reference. Wilf provides specific

definition to the effect that a "transaction amount" is a component of this "transaction detail" as illustrated in the following locations: Col. 1, lines 27-28 and Col. 9, lines 24-29).

- receiving authorization from the customer for billing of the transaction sum, wherein the transaction sum corresponds to the online purchase; and notifying the vendor site of authorization (Col. 2, lines 3-15, 52 – Col. 3, line 12).

Wilf does not explicitly disclose presenting of the transfer amount through an internet interface. However, Stein discloses the presenting of the transfer amount through an internet interface (Col. 7, l. 58 – Col. 8, l. 18). The ordinary practitioner of the art would have seen it as obvious at the time of Applicant's invention that a web browser window was a practical and popular interface for displaying this transaction data for the customer buyer's authorization or rejection of the payment by transfer.

Wilf also does not explicitly disclose receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase; and notifying the vendor site of authorization. However, Stein discloses the use of a debit for making payment for a transaction performed over the internet as payment for the internet purchase's transaction amount (Col. 10, l. 51).

Wilf also does not explicitly disclose opening a pop-up window for the customer. However, Wilf discloses the equivalent of opening a pop-up window for the customer. Applicant admits in his argument that the term "pop-up window" was "notoriously well known" at the time of this parent application's filing date (Appeal Brief, page 4, l. 19; p. 8, l. 6). Further, Applicant admits in his Reply Brief received on July 27, 2005 that "pop-up window is synonymous with a new web browser window, automatically opened and viewable by the customer" (p. 4, ll. 1-3). This argument is convincing as it records Applicant's admission of the "automatically opening a new web browser window for the customer" as Appellant admitted prior art (AAPA), since pop-up windows were an obvious and even ubiquitous automatic phenomenon experienced by millions of web browser users at the time of Applicant's invention. However, this admission does not invalidate the Fung reference for two reasons. First, the Fung reference discloses the the equivalent feature of a pop-up window. Second, a pop-up window is not contained in

Applicant's parent application. This limitation in Applicant's claimed invention therefore only can claim an effective filing date of November 15, 2001, since Fung's effective filing date is March 1, 2000, thus making Fung prior art. As a result, Wilf, combined with AAPA and Fung, do teach "interacting with the pop-up window to present a transaction amount in the pop-up window and receive customer assent to the transaction amount" as the Applicants claim. Hence, it would have been obvious to an ordinary practitioner of the art at the time of Appellant's invention to have combined the disclosure of Wilf, Fung, AAPA and Stein to establish an automated purchasing method for authorizing and checking out from an online purchase between a customer and a vendor site/merchant system which includes efficient automated web based steps and user conveniences for validating the payment for an online transaction without exposing the customer's personal information by maintaining security, motivated by a desire to overcome the reluctance of some users to transmit credit card account information over the internet (Wilf, Col. 1, ll. 24-27).

Re. Claim 2, as discussed in the rejection of claim 1 above, Wilf discloses a method wherein the equivalent of a pop-up window points away from the vendor site by pointing to the transaction server (Col. 2, lines 26-34).

Re. Claim 3, Wilf and Stein disclose a method for authorizing and checking out from an online purchase between the customer and the vendor site comprising a step of receiving account information from the customer corresponding to an account authorized for the debit (Wilf, Col. 2, lines 34-47. See claim 1 re. the debit).

Re. Claim 4, Wilf, Fung and AAPA disclose a method for authorizing and checking out from an online purchase between the customer and the vendor site wherein the equivalent of a pop-up window (i.e. the automatic browser window per the rejection of claim 1 above) overlays an existing web browser window of the vendor site (Wilf, Col. 2, lines 3-5, 47-51).

Re. Claims 5, 13 & 19, Wilf, Fung and AAPA disclose a method for authorizing and checking out from an online purchase between the customer and the vendor site wherein the receiving transaction information step triggers the opening the equivalent of a pop-up window step (Wilf, Col. 2, lines 3-15. See claim 1 above re. pop-up window.).

Re. Claims 6, 14 & 20, Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site further comprising a step of transferring payment to an account associated with the vendor site after authorization is received (Col. 7, lines 45-57).

Re. Claim 7, Wilf, Fung and AAPA disclose a step of presenting a message to the customer in the equivalent of a pop-up window indicating at least one of the following: that authorization was canceled by the customer; that authorization was rejected by a funds transfer system; and that authorization completed normally (Wilf, Col. 7, line 58 - Col. 9, line 20. See claim 1 above re. pop-up window).

Re. Claim 9, Wilf discloses a computer-readable medium having computer-executable instructions for performing the computer-implementable method for authorizing and checking out from an online purchase between the customer and the vendor site of claim 1 (Col. 1, line 63- Col. 2, line 3).

Re. Claim 10, Wilf, Fung and AAPA disclose a method for checking-out from an online purchase by a customer from a merchant system, the method comprising steps of:

- at a funds transfer system, receiving transaction information from the merchant system, wherein the transaction information includes a transaction amount and wherein the funds transfer system is located at a network location away from the merchant system (Wilf, Col. 1, l. 61 – Col. 2, l. 51. See the rejection of claim 1. Further, the funds transfer system is obviously at a location away from the merchant system connected by the world wide web (Wilf, Col. 1, ll. 5-24, 44-49; col. 1, l. 61-col. 2, 3);

- opening a pop-up window that is viewable by the customer, wherein the pop-up window is formulated by the funds transfer system (See the rejection of claim 1.);

- from the funds transfer system, interacting with the pop-up window to present a transaction amount in the pop-up window and receive customer assent to the transaction amount (See the rejection of claim 1. The funds transfer system is the controlling entity, initiating the interaction with and through the pop-up

window equivalent, receiving customer assent to the transaction amount as a
goal of the activity.);

- receiving authorization from the customer for the transaction amount, wherein
  the transaction amount corresponds to the online purchase (Wilf, Col. 2, lines 3-
  15, 52 – Col. 3, line 12); and

- notifying the merchant system of authorization (Wilf, Col. 2, lines 3-15, 52 – Col.
  3, line 12).

Wilf does not explicitly disclose receiving authorization from the customer of a debit for
the transaction amount, wherein the debit corresponds to the online purchase.
However, Stein discloses the use of a debit for making payment for a transaction
performed over the internet as payment for the internet purchase's transaction amount
(Col. 10, l. 51).

Therefore, it would have been obvious to an ordinary practitioner of the art at the time
of Applicant's invention to combine the art of Wilf, Fung and AAPA and Stein to
establish an automated purchasing method for checking-out from an online purchase
by a customer from a merchant system which includes efficient automated web based
steps and user conveniences for validating the payment for an online transaction
without exposing the customer's personal information by maintaining security, motivated
by a desire to overcome the reluctance of some users to transmit credit card account
information over the internet (Wilf, Col. 1, ll. 24-27).

Re. Claim 11, Wilf and Stein disclose a step of receiving account information from the
customer corresponding to an account available for debits by the funds transfer
system (Wilf, Col. 2, lines 34-47. See claim 1 re. the debit).

Re. Claim 12, Wilf, Fung and AAPA disclose a method wherein the pop-up window
overlays an existing web browser window of a web site associated with the merchant
system (The a pop-up window implicitly overlays the existing web browser window
being viewed).

Re. Claim 13, Wilf, Fung and AAPA disclose a method wherein the receiving
transaction information step triggers the opening of a pop-up window step(This
triggering step is implicit to the way a pop-up window or automatically opening window

is implicitly designed to work).

Re. Claim 14, Wilf discloses a comprising a step of transferring payment to an account associated with the merchant system after authorization is received (Col. 2, ll. 14-15).

Re. Claim 15, Wilf discloses a method comprising a step of presenting a message to the customer in another window indicating at least one of the following: that authorization was canceled by the customer; that authorization was rejected by the funds transfer system; and that authorization completed normally. (Col. 7, line 58 - Col. 9, line 20.).

Re. Claim 17, Wilf discloses a method for checking-out from an online purchase by a customer from a merchant system, the method comprising steps of:

- at a funds transfer system that is located at a network location away from the merchant system, receiving account information from the customer (Col. 1, l. 61 – Col. 2, l. 51. See the rejection of claim 1. Further, the funds transfer system is obviously at a location away from the merchant system connected by the world wide web (col. 1, ll. 5-24, 44-49; col. 1, l. 61-col. 2, 3);

- opening a pop-up window that is viewable by the customer, wherein the pop-up window is formulated by the funds transfer system (col. 2, ll. 3-51 - see the rejection of claim 1);

- from the funds transfer system, interacting with the pop-up window to present a transaction amount in the pop-up window and receive customer assent to the transaction amount (see the rejection of claim 1);

- receiving authorization from the customer for the transaction amount, wherein the transaction amount corresponds to the online purchase (Col. 2, ll. 32-47); and

- notifying the merchant system of authorization (Col. 2, lines 3-15, 52 – Col. 3, line 12).

Wilf does not explicitly disclose

- receiving account information from the customer corresponding to an account available for debits by the funds transfer system;

- receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase.

However, Stein discloses the use of a debit for making payment for a transaction performed over the internet (Col. 10, l. 51). This implicitly includes receiving account information from the customer corresponding to an account available for debits by the funds transfer system; and receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase.

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to combine the art of Wilf, Stein, Fung and AAPA with well known art to establish an automated purchasing method which includes efficient automated web based steps and user conveniences for validating the payment for an online transaction without exposing the customer's personal information by maintaining security, motivated by a desire to overcome the reluctance of some users to transmit credit card account information over the internet (Wilf, Col. 1, ll. 24-27).

Re. Claim 18, Wilf, Fung and AAPA disclose a method wherein the account information is received through the pop-up window (Wilf, Col. 2, lines 3-15. See claim 1 above re. pop-up window.).

Re. Claim 19, Wilf discloses method comprising a step of receiving transaction information from the merchant system (Col. 2, lines 3-15.).

Re. Claim 20, Wilf discloses method of transferring payment to an account associated with the merchant system after authorization is received (Col. 2, lines 3-15; Col. 7, lines 45-57).

3.   **Claims 8 & 16 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Wilf, Stein, Fung and AAPA in view of Kolling et al (US Patent 5,920,847, hereafter Kolling).

Re. Claims 8 & 16, none of Wilf, Stein, Fung or AAPA explicitly disclose a method for authorizing and checking out from an online purchase between the customer and the vendor, wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period.

However, Kolling discloses a method for authorizing and checking out from an online purchase between the customer and the vendor site wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period (Col. 37, lines 2-8). It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosure of Wilf with the disclosure of Kolling to establish an automated purchasing method which included a time limit for notifying a vendor of payment approval for an automated transaction in order to protect a vendor from undue delay in verifying such a transaction while minimizing costs, maintaining certain controls and discretionary actions on behalf of the biller, and simplifying the process for all the parties (Kolling, Col. 10, ll. 25-62).

Response to Arguments

4.   Applicant's arguments filed October 3, 2006 with respect to claims 1, 10 and 17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Richard E. Chilcot, can be reached on (571) 272-6777.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231

or (571)*273-8300*   [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC
December 11, 2006

FRANTZY POINVIL
PRIMARY EXAMINER